

## REMARKS

This is intended as a full and complete response to the Final Office Action dated January 29, 2007, having a shortened statutory period for response set to expire on April 29, 2007. Claims 42, 45-62, and 65-67 have been examined. The Examiner rejected claims 42, 45, 46, 49, and 67 under 35 U.S.C. § 103(a) as being obvious over *Simpson '532* in view of *Clark '630* and the pre-grant publication '*704 to Jackson and Bergey*. The Examiner rejected claims 50-57, 59-62, 65, and 66 under 35 U.S.C. § 103(a) as being obvious over *Simpson '532* in view of *Clark '630* and the pre-grant publication '*704 to Jackson*. The Examiner rejected claims 47 and 48 under 35 U.S.C. § 103(a) as being obvious over *Simpson '532* in view of *Clark '630*, *Jackson '704*, and *Bergey* as applied to claim 46 above, and further in view of the pre-grant publication '*769 to Whang*. The Examiner rejected claim 58 under 35 U.S.C. §103(a) as being obvious over *Simpson '532* in view of *Clark '630* and *Jackson '704* as applied to claim 50 above, in further view of the WIPO document '*728 to Simpson, et al*.

### ***Claim Rejections Under 35 U.S.C. § 103(a)***

The Examiner rejected claims 42, 45, 46, 49, and 67 as being obvious over *Simpson, Clark, Jackson, and Bergey*. The Examiner rejected claims 50-57, and 59-62, 65, and 66 as being obvious over *Simpson, Clark, and Jackson*. The Examiner rejected claims 47 and 48 as being obvious over *Simpson, Clark, Jackson, Bergey, and Whang*. The Examiner rejected claim 58 as being obvious over *Simpson, Clark, Jackson, and Simpson, et al*. Applicants respectfully traverse the rejection.

The Examiner failed to establish a prima facie case of obviousness because there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings in accordance with MPEP 2143.03. The Examiner admits that *Simpson* does not disclose a bearing portion between the rolling body and the piston or that *Simpson* does not disclose a roller and shaft that are constructed at an angle relative to the longitudinal axis of the expander tool or that *Simpson* does not disclose a roller that is tapered. The Examiner attempts to

supplement these missing limitations and other missing limitations by utilizing *Clark*, *Jackson*, *Bergey*, and *Wang*. Further, the Examiner concedes in section 9 of the Office Action that any judgment on obviousness is a reconstruction based on hindsight reasoning so long as it does not include knowledge gleaned only from the Applicants' disclosure. The Examiner then goes on to state in the Office Action that the motivation to combine the references is because "it would be done to" or "it is common in the art to" which are general statements rather than a true motivation from the references. Most of the reasons for the motivation to combine the references, as set forth by the Examiner, are gleaned from the Applicants' disclosure. For instance, none of the references cited by the Examiner express a desire for greater variation of thrust placed on an expanding tubular. Furthermore, in section 2 of the Office Action, the Examiner states that it is common to place bearings between moving surfaces. In section 3 of the Office Action, the Examiner states it is common in the art to mate the bearing in relation to a surface. Both of these are common in the art according to the Examiner. Additionally, in section 11 of the Office Action, the Examiner states that it is common for a washer to rotate intermittently with a surface in contact therewith. It is unclear from the Examiner's statements in the Office Action which configuration is actually "common in the art." In other words, the Examiner's reasoning to combine the references is based upon knowledge gleaned from the Applicants' disclosure and therefore impermissible hindsight.

Additionally, as set forth in previous responses, *Jackson* and/or *Bergey* do not constitute analogous art and therefore were improperly relied on by the Examiner. Since the device taught by *Jackson* and *Bergey* serve a completely different purpose than Applicants' expander tool, one skilled in the art would recognize these inventions to be in different fields of endeavor. Further, *Jackson* and/or *Bergey* are not at all relevant to the particular problem solved by Applicants' invention. The specification is clear that the Applicants' invention addresses certain limitations found in prior art expander tools. By contrast, *Jackson* provides an assembly that can be used in a torque converter, such as an automotive transmission system and *Bergey* is directed to a method and apparatus for relieving ground pressure surrounding pvc vent pipes which have been displaced from T-fitting traps in sewers. As persons skilled in the art would recognize,

the problem addressed by *Jackson* and/or *Bergey* has no relation to the problem addressed by Applicants' invention. The Examiner's contention in section 7 of the Office Action that *Jackson* is directed to the problem of washers and in section 8 of the Office Action that *Bergey* is analogous art has no merit. Again, Applicants' invention is directed to expander tools for use in permanent expansion of pipe not to the problem of washers as set forth in *Jackson* or to the problem of relieving ground pressure surrounding pvc vent pipes as set forth in *Bergey*. As such, the Examiner has again used impermissible hindsight to combine two completely unrelated references, in combination with multiple other unrelated references, to render the claims obvious. In addition, as set forth in previous responses, *Wang* does not constitute analogous art and thereby making the Examiner's reliance on *Wang* in a §103(a) rejection impermissible.

Moreover, MPEP 2143 clearly sets forth that all claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). None of the cited references teach or suggest a back bearing body that is matable with a piston, as admitted by the Examiner in section 2 of the Office Action. Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See MPEP 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The reasons stated by the Examiner to combine the references is impermissible hindsight based upon knowledge gleaned from the applicant's disclosure, as set forth herein. Still further, the Examiner must *particularly* identify any suggestion, teaching or motivation from *within* the references to combine the references (emphasis added). See *In Re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The Examiner statements that "it would be done to" or "it is common in the art to" are general statements rather than a motivation from *within* the references to combine the references, as set forth above. The mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references. Finally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16

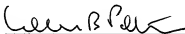
USPQ2d 1430 (Fed. Cir. 1990). The references cited by the Examiner in the Office Action do not suggest the desirability of the combination.

For the reasons discussed herein, the combination of *Simpson, Clark, Jackson* and *Bergey* fails to render claims 42, 45, 46, 49, and 67 obvious. Further, the combination of *Simpson, Clark* and *Jackson* fails to render claims 50-57, 59-62, 65, and 66 obvious. Furthermore, the combination of *Simpson, Clark, Jackson, Bergey*, and *Whang* fails to render claims 47 and 48 obvious. In addition, the combination of *Simpson, Clark, Jackson*, and *Simpson, et al.* fails to render claim 58 obvious. Applicants therefore submit that claims 42, 45-62, and 65-67 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection.

### ***Conclusion***

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



William B. Patterson  
Registration No. 34,102  
PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicants